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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,509	02/24/2004	Paul D. Stevenson	GP-303795	9878

7590 12/19/2005  
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EXAMINER

LEWIS, TISHA D

ART UNIT PAPER NUMBER

3681

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/785,509

Applicant(s)

STEVENSON ET AL.

Examiner

TISHA D. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-9 and 11 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

The following is a response to the amendment received on November 1, 2005 which has been entered.

#### *Response to Amendment*

Claims 1-9 and 11 are pending in the application. Claim 10 has been cancelled.

-The 112 2<sup>nd</sup> rejection of claim 1-11 has been withdrawn due to applicant canceling the indefinite term "type" from the claims.

#### *Response to Arguments*

Applicant's arguments filed November 1, 2005 have been fully considered but they are not persuasive.

-As to applicant's argument concerning the term "type": Although those skilled in the art may know what a rotating or non-rotating transmitting mechanism is, the term "type" added to this makes it indefinite because it is unclear as to what the term "type" is intended to convey, MPEP 2173.05(b), section E.

-As to applicant's argument concerning the criteria for establishing a prima facie obviousness rejection: The examiner acknowledges applicant's recitation of all three criteria, but the third criteria does say that the prior art references **or (references when combined)** must teach or suggest all the claim limitations and therefore, the examiner contends that the references **combined** do meet all the claim limitations, MPEP 2143.

-As to applicant's argument concerning the functions of the bearing, separator plate and cam in the Dairokuno et al reference: The cam 13 slides to engage the separator plate 13 which engages the clutch, the bearing 47 (as applicant stated)

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accommodates relative rotation between the cam 35 and another cam 37. Since cam 35 engages the separator plate 13, it is considered the piston and since plate 13 causes engagement of the other clutch plates, it is considered the apply plate, and since 47 accommodates rotation for at least the cam 35 (piston), the limitation of "the bearing accommodating rotation therebetween" is met, since applicant doesn't expressly say that a rotation of the apply plate and a rotation of the apply piston are accommodated by the bearing. The motivation to combine the references is still taught by Dairokuno et al which is to provide support for the rotation of the piston (cam 35) between the piston and apply plate. Although those skilled in the art may not look to Dairokuno et al for a bearing supporting high speed rotation between a piston and plate, the general concept of having a bearing between a piston and a plate would be looked at (since applicant doesn't disclose high speed as a requirement for the bearing).

-As to applicant's argument that Dairokuno et al reference doesn't teach or suggest all of the claim limitations: One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

-As to applicant's argument about the placement of the separator plate 13: The clutch has a plurality of separator plates and it seems that only one plate was identified to cut down on the redundancy of referencing all the plates with the same reference character.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura et al ('086) in view of Dairokuno et al ('096). Sugiura et al discloses an automatic transmission having an input (12), an output (105), a stationary transmission housing (9), a first planetary gear with first, second and third members (3), a second planetary gear with a plurality of members (4), at least a first (C1) and second (C3) rotating torque mechanism between the input and the planetary gears, the first mechanism (C1) being positioned radially outboard and axially overlapped by the second mechanism (C3), the first mechanism having an apply piston (32) for engaging an apply plate in the transmission housing, the second mechanism having an apply piston (53) for engaging an apply plate in the transmission housing and a third rotating torque mechanism (C2) having an apply piston (47) for engaging an apply plate in the transmission housing, but Sugiura et al does not disclose a bearing disposed between the apply piston and the apply plate.

Dairokuno et al ('096) discloses a torque transmitting mechanism having an apply piston (35) for engaging an apply plate (13) wherein a bearing (47) is disposed between the piston and the plate (Figures 10 and 13).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the torque rotating mechanisms of Sugiura et al with a bearing disposed between the piston and plate in view of Dairokuno et al to provide rotatable support for the piston.

***Allowable Subject Matter***

Claims 5-9 and 11 are allowed.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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Typed or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-Thur 6 AM TO 2:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tdl  
December 14, 2005

  
TISHA LEWIS  
PRIMARY EXAMINER  
AU 3681 12/14/05